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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,637

09/30/2005

Robert Bohm

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10/05/2007

PERRET DOISE

A PROFESSIONAL LAW CORPORATION

P.O. DRAWER 3408

LAFAYETTE, LA 70502-3408

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,637

Applicant(s)

BOHM, ROBERT

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 09/30/2005 – application papers filed.

This application is a 371 of PCT/DE03/02009, filed 06/14/2003.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Following is an action on the MERITS:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siddall (U.S. Patent 6,095,930) in view of Wilson (U.S. Patent 5,071,129). The patent to Siddall shows every feature claimed with the exception of a connection that enables the training device to rotate about an axis perpendicular to the front edge of the striking face. Wilson shows it to be old in the art to attach a training aid to a golf club so that movement both parallel to and perpendicular to the plane of the striking face may be realized in order to optimize the movement of the device so that a player may selectively customize the golf club to fit the his or her particular needs insofar as alignment or positioning of a proper stance at address. See the "SUMMARY OF THE

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INVEVTION" in Wilson. In view of the patent to Wilson, it would have been obvious to modify the alignment aid in the Siddall patent by providing a suitable attaching means, such as a connecting piece, to enable nearly universal movement of the training device to accommodate a number of golfers. Note, Siddall does provide movement at least about an axis parallel to the face (Figure 8). Also, note reflective (86) in Siddall.

Claims 1, 3, 4, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maroun (U.S. Patent 3,403,912) in view of Wilson (U.S. Patent 5,071,129) and Siddall (U.S. Patent 6,095,930). The patent to Maroun shows every feature claimed including a prism arrangement, but fails to show a connection that enables the training device to rotate about an axis both parallel and perpendicular to the front edge of the striking face as well as magnetic attaching means on the club. Wilson shows it to be old in the art to attach a training aid to a golf club so that movement both parallel to and perpendicular to the plane of the striking face may be realized in order to optimize the movement of the device so that a player may selectively customize the golf club to fit the his or her particular needs insofar as alignment or positioning of a proper stance at address. See the "SUMMARY OF THE INVEVTION" in Wilson. Further, Siddall shows that it is old to attach a training device to a club head via magnet means so that the training aid is easily attachable and removable from the club head. In view of the patents to Wilson and Siddall, it would have been obvious to modify the alignment aid in the Maroun patent by providing a suitable attaching means, such as a connecting piece, to enable nearly universal movement of the training device to accommodate a number of golfers.

Claims 1, 6, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avanzini (U.S. Patent 5,213,331) in view of Wilson (U.S. Patent 5,071,129) and Siddall (U.S. Patent 6,095,930). The patent to Avanzini shows every feature claimed including a laser pointer, but fails to show a connection that enables the training device to rotate about an axis both parallel and perpendicular to the front edge of the striking face as well as magnetic attaching means on the club. Wilson shows it to be old in the art to attach a training aid to a golf club so that movement both parallel to and perpendicular to the plane of the striking face may be realized in order to optimize the movement of the device so that a player may selectively customize the golf club to fit the his or her particular needs insofar as alignment or positioning of a proper stance at address. See the "SUMMARY OF THE INVEVTION" in Wilson. Further, Siddall shows that it is old to attach a training device to a club head via magnet means so that the training aid is easily attachable and removable from the club head. In view of the patents to Wilson and Siddall, it would have been obvious to modify the alignment aid in the Avanzini patent by providing a suitable attaching means, such as a connecting piece, to enable nearly universal movement of the training device to accommodate a number of golfers.

Claims 1, 7, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baugh (U.S. Patent 1,556,062) in view of Wilson (U.S. Patent 5,071,129) and Siddall (U.S. Patent 6,095,930). The patent to Baugh shows every feature claimed including an apparatus with a suitable cross-wire, but fails to show a connection that enables the training device to rotate about an axis both parallel and perpendicular to the

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front edge of the striking face as well as magnetic attaching means on the club. Wilson shows it to be old in the art to attach a training aid to a golf club so that movement both parallel to and perpendicular to the plane of the striking face may be realized in order to optimize the movement of the device so that a player may selectively customize the golf club to fit the his or her particular needs insofar as alignment or positioning of a proper stance at address. See the "SUMMARY OF THE INVEVTION" in Wilson. Further, Siddall shows that it is old to attach a training device to a club head via magnet means so that the training aid is easily attachable and removable from the club head. In view of the patents to Wilson and Siddall, it would have been obvious to modify the alignment aid in the Baugh patent by providing a suitable attaching means, such as a connecting piece, to enable nearly universal movement of the training device to accommodate a number of golfers.

Claims 1, 5, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGinty (U.S. Patent 6,923,729) in view of Wilson (U.S. Patent 5,071,129) and Siddall (U.S. Patent 6,095,930). The patent to McGinty shows every feature claimed including an arrangement wherein an apparatus that is able to capture an image is located on the club head face along with a display attached to the grip portion of the shaft, but fails to show a connection that enables the training device to rotate about an axis both parallel and perpendicular to the front edge of the striking face as well as magnetic attaching means on the club. In this case, the applicant's broad recitation of a "TV-camera" may be related to the structure on the clubface that generates a pixel image. The applicant's broad recitation of a "TV-screen" may be related to the display

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apparatus on the club grip. It is clear that a number of ways exist in which a training apparatus may be attached to a golf club. For example, Wilson shows it to be old in the art to attach a training aid to a golf club so that movement both parallel to and perpendicular to the plane of the striking face may be realized in order to optimize the movement of the device so that a player may selectively customize the golf club to fit the his or her particular needs insofar as alignment or positioning of a proper stance at address. See the "SUMMARY OF THE INVEVTION" in Wilson. Further, Siddall shows that it is old to attach a training device to a club head via magnet means so that the training aid is easily attachable and removable from the club head. In view of the patents to Wilson and Siddall, the skilled artisan would have gleaned an appreciation of diverse techniques for attaching a training apparatus to a golf club.

Specification

The disclosure is objected to because of the following informalities:

The specification does not contain the suggested headings to separate the various sections of the text: Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

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- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the specification provides no guidance whatsoever and there is no way to comprehend how the apparatus, configured as a rectangular prism, a TV-camera and TV-screen combination or a laser pointer, is to be attached to the golf club.

Claim Objections

Claims 1, 5 and 8 are objected to because of the following informalities:

As to claim 1, line 1, "the" should be deleted and after "golf", the term --and-- should be inserted. In line 3, "which is" should be deleted and --and-- should be inserted. In line 9, "are" should be deleted and "enabling" should read --enable--.

Further in claim 1 and beginning at line 7, the claim details "wherein the apparatus is attached to the club...", which is a limitation that connotes that the golf club is a part of the of the invention (i.e., a golf club in combination with an aid). However, the preamble of the claim only requires an aid "for facilitating the learning how to play golf...." And does not positively recite the golf club. While the general language of claim 8 parallels the language in claim 1, claim 8 requires the combination of a golf club and an apparatus and therefor does not suffer from the same inconsistency as claim 1..

As to claim 5, here again, the claim requires that the "TV-screen is positioned on the shaft", which connotes that the golf club shaft is being positively recited. However, claim 1 does not positively recite a golf club shaft. Here again, the similarity in language between claims 5 and 12 is self-evident. However, claim 12 refers back to the golf club shaft of claim 5, wherein claim 5 does positively recite a golf club shaft.

As to claim 8, line 1, "the" should be deleted and after "golf" (second occurrence), the term --and-- should be inserted. In line 7, "are" should be deleted and "enabling" should read --enables--.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rectangular prism (claims 4 and 11) along with the TV-camera and TV-screen combination (claims 5 and 12) and the laser pointer (claims 6 and 13), all attached to the golf club so as to redirect the image perceivable in the lone of vision, must be shown or the feature(s) canceled from the claim(s). A generic drawing, as currently presented, does not adequately teach or show how the invention works. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Further References of Interest

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marsh shows an electronic club head and display apparatus;

See Figure 1 in Shu;

Note Figure 2 and display (38) in Johnson;

Observe Figure 2 in Guthry;

Note the camera (36) in Peterson;

Walmsley shows a light emitter (17), of interest.

Nakayama shows a camera and monitor;

Allen shows a computerized club head;

Linn shows a monitor and camera setup;

Note the laser beam device in Nelson;

See Figure 2 in Vella;

Taylor shows a training device;

Note the attachment means in Figure 1 in Grim;

See Figure 1 in Betinis;

Ehmke ('596) and ('022) show a prism arrangement;

See Figure 2 in Susinno;

See Figure 5 in Mazziotti;

Note Figure 1 in Ruggles.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Passaniti/sp
September 29, 2007


Sebastiano Passaniti
Primary Examiner